

REMARKS

Prior to entry of this Amendment, Claims 1-21 were pending and under consideration. With this Amendment, Claims 1, 9 and 10 have been amended and Claims 22-30 have been added. Thus, after entry of this Amendment, Claims 1-30 are pending and under consideration.

The Amendments of the Specification

The abstract was amended to remove the word "said" and to use the word "the" instead.

The Amendments of the Claims

Claims 1 and 9 have been amended to recite the position of at least one tine of the instrument emanates from a location away from the longitudinal sides of the instrument, and not within the end section. Basis for this amendment is found in the specification at least in the embodiment illustrated FIG. 1 and at page 4, lines 29-30 of the specification.

Claim 9 has been amended to correct a typographical error in the phrase "a the".

Claim 10 has been amended to clarify that the instrument is inserted into the fish body. Basis for this amendment is found at least in FIG. 2C.

Claims 22 and 24 have been added and recite that the groove comprises a substantially continuously curved groove. Basis for this description is found at least in the instrument illustrated in FIG. 1.

Claims 23 and 25 have been added and recite that none of the plurality of tines emanate from the straight parallel longitudinal edges of the instrument. Basis for this description is found at least in the embodiment depicted FIG. 1.

Claims 26 and 27 recite that the sides of the instrument comprise straight parallel longitudinal edges of the body of the instrument. Basis for this description is found at least in the embodiment depicted FIG. 1.

Claim 28 has been added, and recites that all of the tines emanate from the end section. Basis for this limitation is found in the specification at page 4, lines 27-28 and in

FIG. 1.

Claims 29 and 30 includes the limitation that the instrument comprises steel or from plastic. Basis for this claim is found in the specification at page 5, lines 17-20.

All of the amendments and claims are supported throughout the specification and claims as originally filed. The amendments do not present new matter and entry is proper.

Objection to the Specification

The abstract was objected to because it allegedly contained legal phraseology. The objection is moot in light of the amendment which has eliminated the use of the word "said".

Rejection of Claims 1-6 Under 35 U.S.C § 102(b)

Claim 1, and dependent claims 2-6, stand rejected under 35 U.S.C § 102(b), as allegedly being anticipated by U.S. Patent No. 2,533,445 (Finney). Applicant traverses the rejection on the basis that each and every limitation of the claims as amended is not described in Finney.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (see MPEP § 2131).

Claim 1 as amended now recites that at least one tine of the plurality of tines emanates from a location away from the sides of the instrument, and not from within the end section. In Finney, the majority of tines emanate from the sides of the instrument; none emanate from a location that is away from the sides and that is also away from the end section. Finney therefore does not meet all of the limitations of claim 1 as amended. Accordingly, since the cited reference fails to teach each and every limitation of the pending rejected amended claim, Applicant requests that the rejection of claim 1, and of dependent claims 2-6, under 35 U.S.C. § 102(b) be withdrawn. The rejection of dependent claims 7 and 8 is similarly requested, as indicated hereinbelow.

Claim 9 has also been amended to include the new limitations as recited in claim 1.

Claims 22 and 24 recite that the groove comprises a substantially continuously curved groove. This limitation is neither described nor suggested by Finney, since the groove of Finney is substantially flat.

Claims 23 and 25 recite that none of the plurality of tines emanate from the straight parallel longitudinal edges of the instrument. This limitation is neither described nor suggested by Finney, since substantially all of the tines emanate from the edges of the instrument of Finney.

Claims 26 and 27 recite that the sides of the instrument comprise straight parallel longitudinal edges of the body of the instrument. This limitation is neither described nor suggested by Finney in which the edges of the instrument are not straight parallel longitudinal edges, but instead are jagged.

Claims 28 and 29 recite that none of the plurality of tines emanates from the sides of the instrument. This limitation is neither described nor suggested by Finney in which essentially all of the tines emanate from the sides of the instrument.

Claim 28 has been added, and recites that all of the tines emanate from the end section. This limitation is neither shown nor suggested in the cited art.

Rejection of Claims Under 35 U.S.C § 103(a)

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentably obvious over Finney in view of Hancchak (4,704,769). The rejection is traversed as applied to Claim 7 on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentably obvious over Finney. The rejection is traversed as applied to Claim 8 on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

In rejecting claims under §103(a), the Patent Office bears the burden of establishing a *prima facie* case of obviousness (MPEP § 2142). To establish a *prima facie* case, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine their teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest each and every limitation of the rejected claims. The teaching or suggestion to make the claimed combination *and* the reasonable

expectation of success must *both* be found in the prior art, and *not* in Applicants' disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 1 as amended includes limitations that are neither shown nor suggested by the cited art, as indicated hereinabove. The references fail to teach each and every limitation of the rejected amended claims. Accordingly, *prima facie* obviousness is not established and the rejection of claims 7 and 8, which depend from claim 1, under 35 U.S.C. § 103(a) should be withdrawn.

Claims 9-12, 14, 16 and 19 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentably obvious over Finney in view of Hanechak (4,704,769). The rejection is traversed as applied to amended Claim 9 and all claims depending therefrom on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

Claims 12 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentably obvious over Finney in view of Hanechak (4,704,769) and further in view of Ewing (4,761,856). The rejection is traversed as applied to amended Claims 12 on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

Independent claim 9 as amended includes limitations that are neither shown nor suggested by the cited art, as indicated hereinabove. The references fail to teach each and every limitation of the rejected amended claims. Accordingly, *prima facie* obviousness is not established and the rejection under 35 U.S.C. § 103(a) of claim 12, which depends from claim 9, should be withdrawn.

Claims 13, 15-18 and 20-21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentably obvious over Finney in view of Hanechak (4,704,769) and further in view of Frick (6,698,133). The rejection is traversed as applied to amended Claim 9 and all claims depending therefrom on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness, as indicated above. The references fail to teach each and every limitation of the rejected amended claims. Accordingly, *prima facie* obviousness is not established and the rejection under 35 U.S.C. § 103(a) of claims 13, 15-18 and 20-21, which depend from claim 9, should be withdrawn.

Conclusion

Applicant submits that Claims 1-30 satisfy all of the statutory requirements for patentability and are in condition for allowance. An early notification of the same is kindly solicited.

Respectfully submitted,
FOOTHILL LAW GROUP, LLP

Date: 6/22/05

/John F. Brady/

By: John F. Brady

Reg. No. 39,118

FOOTHILL LAW GROUP, LLP
3333 Bowers Ave., Suite 130
Santa Clara, CA 95054
Phone: 408-293-0880